

Remarks

Upon entry of the above amendments, this application will contain claims 1, 2, 5, 6, 8, 16, 19, 21-23, 26, and 33-41. Claims 21-23, 26 and 39-41 have been withdrawn from consideration. In this Submission, claims 1 and 5 were amended as described in more detail below. No claims have been added or canceled. In light of the above amendments and the following remarks it is believed that this application is in condition for allowance. Prompt reconsideration leading to the allowance of all pending claims is requested.

I. Rejections Under 35 USC §102(e)

Claims 1, 2, 5, 6, 16, and 19 were rejected under 35 USC §102(e) as being anticipated by US 20090018058, herein after “US 058”.

Claim 1 has been amended by deleting reference to the variable “-CF₃” for R50 in -OSO₂- (R50). Claim 5 has been amended to delete reference to the compounds M4, M5, M12, M22-M25, and M28-M31. It is believed that these amendments overcome the lack of novelty of the claims 1 and 5, and for claims 2, 16, and 19, which depend from claim 1.

Claim 6 is not anticipated by US 058. Claim 6 is an independent claim and does not include compounds in which R_C is -O-SO₂-CF₃. Therefore, it is believed that claim 6 is patentable over US 058.

In light of the above claim amendments and remarks, withdrawal of the rejections of claims 1, 2, 5, 6, 16, and 19 is requested.

II. Rejections under 35 USC §103

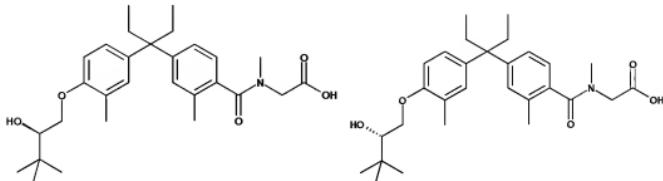
Claims 1, 2, 5, 6, 8, 16, 19, 33-38 were rejected under 35 USC §103(a) over US 058. It is noted that the US 058 reference is listed as prior art only under 35 USC §102(e). The claimed invention of the instant application and the subject matter in the US 058 were, at the time of the claimed invention, owned by the same person or subject to obligation of assignment to the same person. The instant application is assigned to Eli Lilly and Company recorded at 108054/0809; the US 058 reference is assigned to Eli Lilly and Company recorded at R/F 01807/0616. Therefore, the US 058 does not preclude patentability of the instant claims. 35 USC §103(c)(1). Withdrawal of the rejections of claims 1, 2, 5, 6, 8, 16, 19, 33-38 were rejected under 35 USC §103(a) is requested.

III. Provisional Non-Statutory Double Patenting Rejection

Claims 1, 2, 5, 6, 8, 19, and 33-38 were rejected under the grounds of provisional non-statutory double patenting over the claims of copending patent application nos. 10/534,920, 10/538,142, and 10/579,562.

1. USSN 10/534,920

The patent application no. 10/534,920 (Lilly Docket No. X15440) has been allowed and the issue fee paid. (US 058 is the publication of this application.) This patent application contains claims to a pair of enantiomers (acids), their salts and esters, formulations and methods of use. The claimed enantiomeric acids are shown below:



These compounds differ from those claimed notably in the aromatic substituents on the right side-referred to herein as amide acids, which are attached via a carbonyl carbon. The corresponding group, R_C , on the compounds in the instant application are sulfoxides or sulfamides and are different from the amide acids of the cited application. Therefore, the compound claims in the cited reference do not overlap the compound claims in the instant application.

Further, there is no suggestion or teaching proffered that the amide acids make obvious the sulfoxides or sulfamides substituents. Nor is there any suggestion that the cited reference motivates one skilled in the art to modify the compounds in 10/534,920 to arrive at the instantly claimed compounds.

In light of the above comments, withdrawal of the provisional rejection of claims 1, 2, 5, 6, 8, 19, and 33-38 over the claims in USSN 10/534,920 is requested.

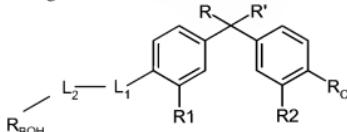
The undersigned wished to inform the Examiner that a continuation application, USSN 12/470,677 (Lilly Docket No. X15440A), has been filed and claims priority to the 10/534,920 application. However, the compounds claimed in that continuation application also do not overlap the instantly claimed compounds.

2. USSN 10/538,142

The patent application no. 10/538,142 (Lilly Docket No. X16140) is abandoned. Consequently, withdrawal of the provisional obviousness type double patenting is requested.

3. USSN 10/579,562

The patent application no. 10/579,562 (Lilly Docket No. X15628) claims compounds having the formula illustrated below:



Both the R_{BOH} and R_C groups in these claimed compounds are different from the compounds claimed in the instant application. Specifically referring the R_C substituents on the cited

reference, these substituents are amide acids attached via a carbonyl carbon. As noted above, the corresponding group, R_C on the compounds in the instant application are sulfoxides or sulfamides. Therefore the compound claims in the cited reference do not overlap the compound claims in the instant application.

Further, there is no suggestion or teaching proffered that the amide acids make obvious the sulfoxides or sulfamides substituents. Nor is there any suggestion that the cited reference motivates one skilled in the art to modify the compounds in 10/579,562 to arrive at the instantly claimed compounds.

In light of the above comments, withdrawal of the provisional rejection of claims 1, 2, 5, 6, 8, 19, and 33-38 over the claims in 10/579,562 is requested.

IV. Conclusion

In light of the above claim amendments and comments withdrawal of all rejections is requested. Applicants respectfully request timely reconsideration examination of this application leading to allowance of all elected claims. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Response or other issues that may be resolved in that fashion.

Respectfully submitted,

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